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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/749,166	12/30/2003	Matthew A. Szymanski	381.047	7821

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EXAMINER

EINSMANN, MARGARET V

ART UNIT	PAPER NUMBER
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1751

DATE MAILED: 11/03/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	10/749,166	SZYMANSKI, MATTHEW A.	
	Examiner	Art Unit	
	Margaret Einsmann	1751	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 21 September 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-19 is/are pending in the application.
- 4a) Of the above claim(s) 18 and 19 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-17 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>5/3/2004; 6/1/2004</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Applicant's election of Group I, claims 1-17 in the reply filed on 9/21/05 is acknowledged. Because applicant did not distinctly and specifically point out the supposed errors in the restriction requirement, the election has been treated as an election without traverse (MPEP § 818.03(a)).

Claims 1-17 are being examined in this action. Claims 18 and 19 are withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to a nonelected invention.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) and the Intellectual Property and High Technology Technical Amendments Act of 2002 do not apply when the reference is a U.S. patent resulting directly or indirectly from an international application filed before November 29, 2000. Therefore, the prior art date of the reference is determined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

Claims 1-5 and 9,10, 12-14,16,17 are rejected under 35 U.S.C. 102(b) as being anticipated by Clark et al., US RE. 24,554.

Example 1 and 2 in columns 3 and 4. disclose paper (a cellulosic substrate) which has been dyed with a colorant composition comprising a pigment, thickener and a solvent and then coated with an overcoating. Regarding claim 3, the colorant in both examples are provided as dispersions, indicating that the colorants are in the form of particles and thus were provided in the form of dry coloring matter, meeting the limitation claim 3. Regarding claim 4, the rubber which acts as thickener is provided in amounts of approximately 1% in example 1 and approximately 3% in example 2. The pigment is present in examples 1 and 2 in an amount of about 17%, meeting the limitations of claims 9 and 10. The overcoat comprises latex crepe rubber meeting the limitations of claims 12 and 14. Regarding claims 16 and 17, the coatings are applied by means of a spreader knife or bar. In the examples described above, the overcoat comprises a latex rubber. However, in example 15 in col 13, the colored paper may also

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be coated with a treating composition comprising a methyl methacrylate polymer, meeting the limitation of claim 13.

Accordingly all of the material limitations of the claims are met.

Claims 1-6,12-14,16 and 17 rejected under 35 U.S.C. 102(b) as being anticipated by Cabot Corporation, WO 99/23179. Multilayered coatings for use in paperboard or paper are disclosed wherein the coating contains at least two layers. The first layer comprises at least one dark colorant and at least one binder. See abstract. Tables 1 and 2 on page 15 disclose the formulation of a colorant containing base coat. The thickener comprises the synthetic thickener SBR latex as well as the natural thickener, sodium alginate. The colorant comprises dry pigments, including carbon black, black iron oxide and blue pigment. The solvent is water. That base coat was covered with top coat formulations. Tables 3 and 4 on page 16 describe these formulations. They also comprise the SBR latex. Accordingly the limitations of claims 1-6, 12-14 are met. Regarding claims 16 and 17, both coating compositions were applied using a cylindrical lab coater as described on page 16 lines 33-35.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and

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the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 11 and 15 are rejected under 35 U.S.C. 103(a) as being unpatentable over Clark et al. Clark is applied as set forth in the above rejection as teaching a method of applying a thickened colorant solution to paper and then applying an overcoat. In the examples described above, the application rate of the colorant composition or overcoat is described in terms of the thickness of the applied coating and not in terms of the weight of the substrate as claimed. It would have been obvious to the man having skill in the art at the time the invention was made to adjust the coating thickness so that the paper is not overloaded and still is useful for his intended purpose, and it is seen that the spreader knife or bar used in the examples is readily adjustable to provide any coating weight needed. See example 1 wherein the coating layers are applied at various thicknesses. (col 3 lines 50 and 58).

Claims 1-3,5-8 are rejected under 35 U.S.C. 103(a) as being unpatentable over The Dow Chemical Company, EP 1,176,255 A1.

Dow discloses a pigmented coating composition comprising a starch dispersion as binder which is used as a coating color for paper. See abstract. Table 1 on page 7 shows an aqueous precoat formulation comprising calcium carbonate pigment, latex, two different starches and CMC as binders (thickeners). See also claim 1 on page 10. the reference differs from the claims in that there is no showing of the application of said pigmented coating composition comprising starch to paper or paperboard and then

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applying an overcoat as claimed. It would have been obvious to the man having skill in the art of papermaking to apply an overcoat as claimed to the color coated papers of Dow because Dow states that the coating compositions of Table 1 are precoat compositions which is a teaching that at least one overcoating will be applied.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claim 6 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 6 should affirmatively recite that the thickeners are natural thickeners.


Any inquiry concerning this communication or earlier communications from the examiner should be directed to Margaret Einsmann whose telephone number is 571-272-1314. The examiner can normally be reached on 7:00 AM -4:30 PM M-W and alternate Fridays.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Yogendra Gupta can be reached on 571-272-1316. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

10/31/2005


Margaret Einsmann
Primary Examiner
Art Unit 1751